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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,377	09/26/2005	Hideo Toyoda	000023-064	6517
21839 7590 02/04/2008 BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			EXAMINER KARPINSKI, LUKE E	
			ART UNIT 4173	PAPER NUMBER
			NOTIFICATION DATE 02/04/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com  
debra.hawkins@bipc.com

**Office Action Summary**

Application No.

10/531,377

Applicant(s)

TOYODA ET AL.

Examiner

LUKE E. KARPINSKI

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 4-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u>                                    | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Attachment(s) 3. Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :10/25/2005, 09/26/2005, 04/15/2005.

## **DETAILED ACTION**

### **Restriction requirement**

1. Applicant's election without traverse of Invention I (claims 1-3) in the reply filed on 11/07/2007 is acknowledged.

### **Claims**

Claims 1-35 are pending in this action.

Claims 4-35 are withdrawn as non-elected subject matter.

Claims 1-3 are under consideration in this action.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

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Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

### **Claims 1-3**

3. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6,635,715 to Datta et al. as evidenced by Patent No. 6,153,354 to Katsumata et al.

4. Datta et al. teach an olefin wax which is a copolymer comprising ethylene, an olefin, and a diene (col. 4, lines 56-61 and col. 5, lines 26-29). It is noted by the Examiner that propylene is an olefin as disclosed in the Applicants specification (page 13, lines 4-5). Datta et al. also teach the content of unsaturated groups per molecule to be between 0.5 and 3. The fact that the polymer is made of ethylene and propylene, which have no unsaturated groups, and vinyl norbornene (col. 5, lines 33-38), which has one unsaturated group and is found only at either end of the molecule, means that each molecule will have only 1-2 unsaturated groups. Datta et al. also teach the melting point in the range of 70 to 130°C (col. 8, lines 1-10). Datta et al. also teach the ratio (Mw/Mn) of the weight average molecular weight to the number average molecular weight is not more than 4 (col. 9, lines 38-42). It is well known in the art that the molecular weight distribution is equal to (Mw/Mn) (Katsumata et al. col. 3, lines 20-22). Using the equation  $Mw/Mn = \text{ratio}$ ; and the Mw value of 5000 (col. 9, line 41) and the ratio of 4 (col. 9, line 42), it can be calculated that the composition taught by Datta et al. has a Mn value of 1250. Datta et al. also teaches the olefin wax prepared by the use of

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a metallocene catalyst (col. 5, lines 8-11). Although Datta et al. do not explicitly teach that the density of the composition is in the range of 870 to 980 kg/m<sup>3</sup>, it is the examiners position that the density is inherent. The compositions of Datta et al. have the same components at the same percentages and the same molecular weights; thus it would be expected that the compositions of Datta et al. would have a density within the same range (MPEP Section 2112.01). The Examiner has made a reasonable rational for inherency. The office does not have the facilities to test the density of the compositions of Datta et al.; therefore the burden has shifted to the Applicant to show that the compositions of Datta et al. do not have a density within the claimed.

### **Conclusion**

Claims 1-3 are rejected.

Claims 4-35 are withdrawn as non-elected subject matter.

### **Inquiries**

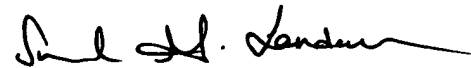
Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUKE E. KARPINSKI whose telephone number is (571)270-3501. The examiner can normally be reached on Monday-Thursday 9-4 est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LEK



SHARMILA GOLLAMUDI LANDAU  
PRIMARY EXAMINER